

EVIDENCE APPENDIX

EXHIBIT A: Final Office Action dated June 22, 2006.

EXHIBIT B: Advisory Action dated October 4, 2006

EXHIBIT C: Notice of Panel Decision from Pre-Appeal Brief Review, dated December 27, 2006

EXHIBIT D: *Bush* (US Patent 5,475,585) cited by the Examiner in the Office Action dated June 22, 2006.

EXHIBIT E: NPL document, "ALANTEC: ALANTEC DELIVERS ANOTHER INDUSTRY FIRST; IP MULTICAST ROUTING SUPPORT FOR DESKTOP VIDEO CONFERENCING AND BROADCAST VIDEO," Business Wire, August 16, 1993

RELATED PROCEEDINGS APPENDIX

None

APPENDIX A

Final Office Action dated June 22, 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,511	11/14/2000	David K. Gifford	06543-002006	8013
24573	7590	06/22/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC PO BOX 1135 CHICAGO, IL 60690-1135			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 06/22/2006

Due: 9-22-06

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
BELL, BOYD & LLOYD
INTELLECTUAL PROPERTY DOCKET

JUN 26 2006

ATTY *[Signature]*
DOCKET # *115224-015*

Office Action Summary

Application No.

09/711,511

Applicant(s)

GIFFORD, DAVID K.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed April 4, 2006.

Claim 5 has been renumbered as claim 23 (since an earlier version of claim 5 was previously cancelled).

Claims 1, 4, and 23 have been amended.

Claims 1-4 and 23 are pending.

Response to Arguments

2. Applicant's arguments filed April 4, 2006 have been fully considered but they are not persuasive.

Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or

Art Unit: 3623

declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not "specifically point[ed] out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Applicant's broad request for references to support Examiner's statement of Official Notice amounts to nothing more than an unsupported challenge. Consequently, the statement of Official Notice made in the art rejection has been established as admitted prior art due to Applicant's failure to adequately traverse the Examiner's assertions of Official Notice. Therefore, Applicant has not sufficiently switched back to the Examiner the burden of supplying references in support of her assertions of Official Notice. It should also be noted that the Official Notice in question has included a real-world example in support of the Official Notice statement in the rejection. Applicant has not explained why it is felt that the Official Notice statement is allegedly untrue.

Applicant continues to argue that the art rejection does not address limitations that should be read into the claims from the specification based on an invocation of 35 U.S.C. 112, 6th paragraph. However, Applicant specifically points out, "There is no mention of any kind of network transfer protocols or hypertext conventions of the WWW

Art Unit: 3623

(see, e.g. specification page 11, second paragraph).” (Page 6 of Applicant's response)

While the claims are read in light of the specification, not all limitations will be incorporated into the claims from the specification. Regarding means-plus-function language, only the structure needed to perform the recited functionality is read into the claims from the specification. In the instant case, a processor, storage device, and network (as taught by the Bush reference) are needed to perform the recited functionality. The specific network transfer protocols and hypertext conventions of the WWW are not structural limitations *per se* nor does the specification clarify that they are inherent to the structure corresponding to the recited means-plus-function language. Now that the Applicant has amended the claims to expressly recite that the digital advertisement is communicated to a buyer over the network “using Internet transfer protocols,” such a limitation will be addressed in the art rejection below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush (U.S. Patent No. 5,475,585) in view of “ALANTEC: ALANTEC Delivers Another Industry First; IP Multicast Routing Support for Desktop Video Conferencing and Broadcast Video,” herein referred to as ALANTEC.

Art Unit: 3623

Bush discloses a network sales system comprising:

[Claim 1] a plurality of buyer computers and at least one merchant computer interconnected by a communications network (col. 1, lines 8-27, 56-59 -- Bush's invention is targeted to customers of cable TV, thereby implying that multiple cable customers may access Bush's service via cable transmission; Fig. 1A),

means at each merchant computer for maintaining and providing a database of digital advertisements (Fig. 1A; col. 3, lines 1-20; col. 5, lines 10-19) comprising:

means for storing said digital advertisements, each digital advertisement including a product abstract (Figs. 1A-5, 8; col. 3, lines 52-54; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed. Also, a brief description, i.e., an abstract, of various products and services may be advertised to a customer),

means for communicating a digital advertisement to a buyer computer over said network in response to a network request from said buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at each buyer computer for requesting, displaying, and responding to digital advertisements (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at

Art Unit: 3623

said merchant computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-8),

display means for displaying said advertisement (col. 3, lines 1-20; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to said merchant computer (Figs. 1A-5, 8; col. 3, lines 50-54; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),

account identification means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means, at said merchant computer, comprising:

authorization means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 4, line 67 through col. 5, line 23; col. 6, lines 46-48 -- In one scenario, the merchant computer must submit transaction information to the financial system network in order to provide a cross-check before the financial transaction is verified, as explained in detail in col. 3, line 60 through col. 4, line 10),

fulfillment means to send said product to user conditional on approval of said authorization means (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment);

[Claim 3] wherein said account identification means comprises:

Art Unit: 3623

means for assembling a payment order (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means for sending said payment order to a network payment system for authorization (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

and wherein said authorization means comprises:

means for verifying that said payment order has been previously authorized by said payment system (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48).

Regarding claim 1, Bush transmits video (including related advertisements) over a packet-switched network (abstract; col. 5, lines 7-9; col. 6, lines 4-9; and col. 10, lines 58-64), yet Bush does not expressly teach that the digital advertisements are communicated to a buyer over the network using Internet transfer protocols. However, ALANTEC discloses the use of IP (Internet protocol) multicast routing to distribute television and video (ALANTEC: ¶ 2). IP multicast routing is used to “build high-performance, low-cost networks” (ALANTEC: ¶ 4) and provide the further benefit of enabling one-to-many communications “without broadcasting the packet to every network device and degrading the performance of the entire network” (ALANTEC: ¶ 6). ALANTEC provides a benefit that is reasonably pertinent to Bush’s type of video distribution system. Furthermore, the Internet is a type of packet-switched network and Bush’s communications may be conducted over a packet-switched network. Consequently, Bush’s system is fully adaptable to functioning over the Internet;

Art Unit: 3623

therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Bush to expressly communicate its digital advertisements to buyers over an network using Internet transfer protocols in order to upgrade Bush's network with "high-performance, low-cost networks" (as suggested by ALANTEC: ¶ 4) and provide the further benefit of enabling one-to-many communications "without broadcasting the packet to every network device and degrading the performance of the entire network" (also suggested by ALANTEC: ¶ 6).

[Claim 2] Bush discloses an authorization means at the merchant computer (as discussed in the rejection of claim 1 above); however, Bush does not expressly teach the details of what occurs if it is determined that certain payment information is missing. Official Notice is taken that it is old and well-known in the art of financial transactions to request additional information if needed to complete a financial transaction. For example, Bush specifically addresses credit card transactions and it is old and well-known to request additional credit card information when needed. This additional information may include a credit card holder's address, security code, name as exactly printed on the credit card, etc. The request for additional information during a credit card transaction provides added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card). The limitations of claim 2 are merely directed toward the means for electronically performing such a request for missing information; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the

Art Unit: 3623

time of Applicant's invention to adapt Bush's electronic credit card authorization means to incorporate means for communicating a missing payment information request message to said buyer computer to obtain missing payment information, means for receiving said missing payment information from said buyer computer, means for authorizing said purchase message by sending messages into a financial system network, wherein said account identification means at said buyer computer comprises means responsive to said missing payment information request message to query the user for additional payment information and means to send said additional payment information to said merchant computer in order to facilitate the quick and efficient retrieval of additional information needed to complete a credit card transaction, thereby providing added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card).

Bush discloses an electronic sales system comprising:

[Claim 4] means for storing a database of digital advertisements, each digital advertisement for a product including a program (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed),

means for communicating a digital advertisement to a buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

Art Unit: 3623

means at said buyer computer for displaying and responding to said digital advertisement (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

display means for displaying said digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program (col. 3, lines 1-10; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to a merchant computer (Figs. 1A-5, 8; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),

means, at said merchant computer, comprising:

fulfillment means to send said product to said user (col. 3, lines 52-54; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment).

Regarding claim 4, Bush transmits video (including related advertisements) over a packet-switched network (abstract; col. 5, lines 7-9; col. 6, lines 4-9; and col. 10, lines 58-64), yet Bush does not expressly teach that the digital advertisements are communicated to a buyer over the network using Internet transfer protocols. However, ALANTEC discloses the use of IP (Internet protocol) multicast routing to distribute television and video (ALANTEC: ¶ 2). IP multicast routing is used to “build high-performance, low-cost networks” (ALANTEC: ¶ 4) and provide the further benefit of enabling one-to-many communications “without broadcasting the packet to every network device and degrading the performance of the entire network” (ALANTEC: ¶ 6).

Art Unit: 3623

ALANTEC provides a benefit that is reasonably pertinent to Bush's type of video distribution system. Furthermore, the Internet is a type of packet-switched network and Bush's communications may be conducted over a packet-switched network. Consequently, Bush's system is fully adaptable to functioning over the Internet; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Bush to expressly communicate its digital advertisements to buyers over an network using Internet transfer protocols in order to upgrade Bush's network with "high-performance, low-cost networks" (as suggested by ALANTEC: ¶ 4) and provide the further benefit of enabling one-to-many communications "without broadcasting the packet to every network device and degrading the performance of the entire network" (also suggested by ALANTEC: ¶ 6).

[Claim 23] Claim 23 recites limitations already addressed by the rejection of claim 4 above; therefore, the same rejection applies. Furthermore, it should be noted that Bush's "means for communicating a digital advertisement to a buyer computer" may be packet-switched means. See at least col. 5, lines 7-9; col. 6, lines 4-9; and col. 10, lines 58-64 of Bush.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3623

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

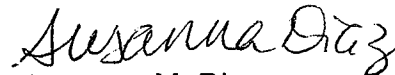
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Susanna M. Diaz
Primary Examiner
Art Unit 3623

June 17, 2006

Notice of References Cited	Application/Control No. 09/711,511		Applicant(s)/Patent Under Reexamination GIFFORD, DAVID K.	
	Examiner Susanna M. Diaz		Art Unit 3623	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	"ALANTEC: ALANTEC Delivers Another Industry First; IP Multicast Routing Support for Desktop Video Conferencing and Broadcast Video." Business Wire (Dialog File 810, Accession No. 0351010), August 16, 1993.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.